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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RALPH MICHAEL FAY,
BLAKE BOYD BOGRETT, JOHN BROOKS SMITH,
and ANGELA ROBIN BRATSCH

Appeal 2009-000895
Application 10/678,911
Technology Center 1700

Decided: December 31, 2009

Before CHARLES F. WARREN, PETER F. KRATZ, and
MARK NAGUMO, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

DECISION ON APPEAL

Applicants appeal to the Board from the decision of the Primary Examiner finally rejecting claims 56, 58, 60, and 61 in the Office Action mailed October 20, 2005. Applicants subsequently amended claim 56 and canceled claims 58, 60, and 61 in the Amendment filed February 17, 2006, entered in the Office Action mailed March 8, 2006. The Examiner refused to allow claim 56 as amended. Claim 56 is the sole claim considered on appeal. 35 U.S.C. §§ 6 and 134(a) (2002); 37 C.F.R. § 41.31(a) (2008).

We reverse the decision of the Primary Examiner.

Claim 56 illustrates Appellants' invention of a faced building insulation assembly:

56. A faced building insulation assembly, comprising:

a resilient fibrous insulation layer; the resilient fibrous insulation layer having a length of about 46 inches or more, an uncompressed width of about 15 inches or more, and a thickness of about 3 inches or more; the resilient fibrous insulation layer having a longitudinally extending centerline; the insulation layer having lateral surfaces defined by the length and thickness of the resilient fibrous insulation layer; the resilient fibrous insulation layer having first and second surfaces defined by the length and width of the resilient fibrous insulation layer and extending between the lateral surfaces of the resilient fibrous insulation layer; the first surface of the resilient fibrous insulation layer having longitudinally extending lateral edge portions adjacent the lateral surfaces of the resilient fibrous insulation layer that are at least 0.25 inches in width; the resilient fibrous insulation layer being compressible in the direction of its width from the uncompressed width to a lesser width;

a facing sheet with no folds therein; the facing sheet being fungi growth resistant; the facing sheet having a first outer surface and a second inner surface; the second inner surface of the facing sheet being bonded to the first surface of the resilient fibrous insulation layer; the facing sheet overlying and being substantially coextensive with the first surface of the resilient fibrous insulation layer and having lateral edge portions overlying but not bonded to the lateral edge portions of the first surface of the resilient fibrous insulation layer so that, when the resilient fibrous insulation layer is compressed to the lesser width, the lateral edge portions of the facing sheet extend as tabs beyond the lateral surfaces of the resilient fibrous insulation layer; and

the facing sheet and the resilient fibrous insulation layer being separable longitudinally by hand to separate the faced building insulation assembly into faced insulation sections having lesser widths than the uncompressed width of the faced building insulation assembly; and the facing sheet not being bonded to the resilient fibrous insulation layer where the facing sheet and the resilient fibrous insulation layer are longitudinally separable to form the faced insulation sections.

The Examiner relies upon the evidence in these references (Ans. 3):[1]

Schwartz	US 2,786,004	Mar. 19, 1957
Walter	US 3,140,220	Jul. 7, 1964
Ruid	US 6,231,927 B1	May 15, 2001

Appellants request review of the ground of rejection of claim 56 under 35 U.S.C. § 103(a) over Walter in view of Ruid and Schwartz advanced on appeal by the Examiner. App. Br. 5; Ans. 3.

Opinion

We are of the opinion that Appellants have established that the evidence in the totality of the record weighs in favor of the nonobviousness of the claimed faced building insulation assembly encompassed by claim 56. *See, e.g., In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992) ("After evidence or argument is submitted by the applicant in response, patentability is determined on the totality of the record, by a preponderance of evidence with due consideration to persuasiveness of argument.") (citing, *inter alia*, *In re Spada*, 911 F.2d 705, 707 n.3 (Fed. Cir. 1990)).

The dispositive issue is whether the Examiner has established that Walter's thermal insulation comprising sheet liner 14 secured to insulating material body 10 by interfacial adhesive 15, is capable of "being separable longitudinally by hand . . . into faced insulation sections" as required by claim 56. Walter, e.g., col. 2, ll. 31-35, and Fig. 1. *See* Br. 5-7; Ans. 6-7.

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[1] We consider the Brief filed February 26, 2008, and the Examiner's Answer mailed July 3, 2008.

In this respect, Walter teaches that the thermal insulation is formed as a wide web in a manner to be slit into a plurality of narrower lengths. Walter, e.g., col. 1, ll. 16-23 and 43-46, and col. 3, ll. 27-35. In the embodiment illustrated in Walter's Figure 5, "[t]he [asphalt] adhesive on the liner may be lacking at the regions which are to be slit . . . ." Walter col. 4, ll. 62-68. Walter also teaches that in the embodiment illustrated in Figure 6, dotted lines 65 "for convenience" in slitting are shown on insulation wide web 55 opposite "sheet liner 58 faced over its entire surface with hot liquid asphalt 59 as the adhesive." Walter col. 5, ll. 1-24.

A discussion of Schwartz and Ruid is not necessary to our decision. *See* Br. 7.

We determine that the claim language "the facing sheet and the resilient fibrous insulation layer being separable longitudinally by hand to separate the faced building insulation assembly into faced insulation sections having lesser widths than the uncompressed width of the faced building insulation assembly," when considered in light of the disclosure in the Specification, means the "faced building insulation assembly" is capable of being "pulled apart or separated by hand," that is, without using any tools. *See* Spec., e.g., 23:35 to 24:6. *See, e.g.*, *In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007); *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004), and cases cited therein; *In re Morris*, 127 F.3d 1048, 1054-55 (Fed. Cir. 1997).

On the totality of the record, we agree with Appellants that the Examiner has not established that Walter's wide web insulation material can be separated by hand into smaller sections as claimed. Br. 6-7. We determine that this is so whether or not the facing sheet is secured to the insulation web by adhesive in the embodiments illustrated in Walter's Figures 5 and 6, relied on by the Examiner, where the thermal insulation is to be slit following Walter's method of manufacture. Ans. 4 and 6-7. Indeed, the Examiner's position that Walter's wide web insulating material is "capable of being separated using a slitting tool in the hands of the user who performs the slitting" does not establish that the user can separate the wide web "by hand" per se as claimed. See Ans. 6-7.

Accordingly, Appellants have shown that the Examiner has adduced insufficient evidence of prima facie obviousness. *See, e.g., In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("'On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of *prima facie* obviousness.'") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)). Thus, we reverse the ground of rejection advance on appeal.

The Primary Examiner's decision is reversed.

REVERSED

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